

Appln. No. 09/921,856
Response dated Jan. 25, 2006
Reply to Office Action of Oct. 25, 2005
Docket No. BOC9-2000-0082 (217)

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of October 25, 2005 (Office Action). As this response has been timely filed within the 3-month shortened statutory period, no fee is believed due.

Disposition of the Application to Date

This is Applicants' seventh response to differing sets of references. Claims 1-17 were rejected in the current Office Action on the basis of a new set of references, even though Applicants' last response made no further amendments to the claims. Applicants, therefore, have assumed that the arguments presented in the last response were deemed persuasive and that the claims define over the previously cited references. Applicants respectfully request clarification if the stated assumption is not, in fact, correct.

In the current Office Action, Claims 1-9 and 11-17 were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,073,138 to de l'Etraz, *et al.* (hereinafter de l'Etraz). Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over de l'Etraz in view of U.S. Published Patent Application No. 2002/0042772 to Rudman, *et al.* (hereinafter Rudman).

Applicants' Invention

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. Applicants' invention is directed to a method, system, and apparatus for identifying common contacts through which people can establish relationships. Applicants' invention facilitates establishment of these relationships by identifying and listing contacts, such as social and/or business contacts, that are shared by the parties even though the parties themselves may be initially unaware of any specific contacts that they have in common.

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In one embodiment, contact lists of different users can be compared with one another to determine whether the users associated with the contact lists have any acquaintances or contacts in common with one another. In another embodiment, mutual contacts of different users can be identified despite the fact that such mutual contacts are known through several "degrees of separation." Accordingly, Applicants' invention can analyze at least two unique contact lists, each of which corresponds to a different user.

Claims 1-3, 12-14

Independent Claims 1 and 12 are directed, respectively to a computerized method and machine-readable storage for generating a list of common contacts. The method includes first retrieving a plurality of contacts from a remotely accessible contact list that defines a first set associated with a user, and first comparing the first retrieved contacts to stored contacts in a locally accessible contact list defining a second set associated with a different user, the first and second sets being distinct from one another. The method further includes identifying common contacts among the first compared contacts. With respect to the comparing of contact lists and identifying common contacts, each claim explicitly recites the following:

first comparing said first retrieved contacts to stored contacts in a locally accessible contact list, said locally accessible contact list defining a second set distinct from said first set and associated with a different user;

and

first identifying common contacts among said first compared contacts.

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It is asserted at page 2 of the Office Action that both the comparing of a first retrieved contact list with a locally accessible stored contact list, as well as the identifying of common contacts, are found in de l'Etraz. The exact language of the portions of de l'Etraz cited in the Office Action is instructive regarding the differences between de l'Etraz and Applicants' invention. The cited portions read as follows:

"In an embodiment of the present invention, the CIDM tool allows a user to directly input into the PC 106 their private contact information. Such input may be entered manually (i.e., entry by entry) in order to populate [a] database 104 [containing private contact information]. Such manual entry would be utilized by users who currently hold their contact information in memory or in a non-electronic address book format. Such information would include, for example, person, organization, department, role (i.e., position), nationality, address, telephone numbers, etc." (Col. 15, lines 11-20.)

"In an alternative embodiment, the CIDM tool may accept private contact data from each user in a batch format. That is, the CIDM tool would allow the transfer of personal contact information from a user's electronic files. In one embodiment of the present invention, the CIDM tool may accept data input to populate the private database 104 directly from several of the commercial available contact manager software applications." (Col. 15, lines 21-28.)

Applicants respectfully maintain that de l'Etraz's entry of contact information – whether by manual entry or in batch form – drawn from a persons memory or address book, electronic or non-electronic, has nothing to do with an electronic, computer-

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implemented retrieval and comparison of two separate lists. Indeed, the data entry in de l'Etraz does not even encompass two distinct sets of contacts, but rather only the transfer of one person's contacts from the person's memory or address book into another format. (Col. 15, lines 11-13, lines 21-22.) Without separate lists, de l'Etraz can not be read as comparing different lists. Moreover, without a comparison, de l'Etraz is incapable of identifying elements common to two separate lists. The exact language of the reference reveals that de l'Etraz does not teach, expressly or inherently, the comparing of a first retrieved contact list with a different, locally accessible stored contact, as recited in independent Claims 1 and 12. Nor does de l'Etraz expressly or inherently teach identifying contacts common to two separate lists, as further recited in each of the claims.

A fundamental reason for this and other differences described below between de l'Etraz and Applicants' invention is the respective results each is intended to achieve. Applicants' system, device, and methods are directed to the discovery of contacts that are common to two or more entities. By contrast, de l'Etraz uses "relational patterns" to "merge" or "combine" *different* contacts of different individuals "in order to explore the full scope (or sphere) of an individual's or business concern's scope of influence." (See, e.g., Col. 5, lines 24-63; Col. 16, line 58 – Col. 17, line 2; See also Abstract; Col. 18, lines 48-63; Col. 19, lines 36-60; and Col. 21, line 44 – Col. 45, line 10.)

In the operative examples described in de l'Etraz, two members of an organization (e.g., a corporation) "merge" or "combine" contacts, based on "relational patterns", which according to de l'Etraz, increases the organization's "sphere of influence." The differences between de l'Etraz's merging of contacts into an enterprise-wide database and Applicant's identifying of common contacts from separate contact lists is demonstrated by a hypothetical in which two members of an organization each have 10 contacts, only one of which is common to both. Applicant's invention compares the separate contact lists and produces a single-element set, the common contact. A merger of the same contact lists, as with as with de l'Etraz, results in a set of 19 unique contacts. The set that

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results from de l'Etraz's merger of contacts based on relational patterns indeed increases the "scope" of the organization's contacts, but it tells neither individual which contacts they share in common. This is a fundamental difference between de l'Etraz and Applicants' invention, and, at least partly, underscores the reason that the exact features of each are fundamentally different.

With regard to the specific features recited in independent Claims 1 and 12, each further recites the following:

second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contact;

second comparing said second retrieved contacts to said locally stored contacts;

and,

second identifying common contacts among said second compared contacts.

The above portions of de l'Etraz are again cited, along with additional portions at page 3 of the Office Action, as disclosing this feature. As already noted, however, the exact language of the above portions of de l'Etraz disclose neither a comparison of contact lists nor an identification of contacts common to both lists. The additional portions cited merely emphasize that de l'Etraz is not directed to identifying common contacts found in disparate contact lists, but rather in merging separate contact lists to increase a "sphere of influence":

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"[In updating data, A]n accurate database of public information (i.e., memberships on company boards of directors) can be provided by the contact intelligence service provider that would allow users to reliably merge their private contact data in order to ascertain their precise and up-to-date sphere of influences. The benefits and advantages of the present invention, as described herein, are provided when accurate public data is provided by the contact intelligence service provider or other vendors of publicly available data." (Col. 16, lines 57-67.)

Another portion of de l'Etraz cited at page 3 of the Office demonstrates that the merged database need not comprise a single entity, but rather can comprise multiple, linked databases:

"While two separate databases . . . are shown in FIGS. 1A-1C for ease of explanation, it will be apparent to one skilled in the relevant art(s) that the CIDM system 100 may utilize databases physically located on one or more computers which may or may not be the same as PC 106 or server 110, as applicable.

"In a preferred embodiment of the present invention, as described below in greater detail, databases 102 and 104 would reside on the same physical media, but separated as two virtual databases. Further, in alternate embodiments, CIDM system 100 can utilize many different schemes for allocating where the public and private data physically resides within the system. For example, in the Internet subscriber embodiments of the present invention, the private contact information database 104 may reside locally (i.e., within PC 106), while the public information database(s) 102 reside

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within the contact intelligence service provider's infrastructure and made accessible to the server 110.

"The enterprise versions described above, in an alternative embodiment, may also have three levels of private contact data stored within private database 104 which the CIDM system 100 may utilize. The first level would be the entity's private contact data which includes the private contact data of each of the enterprise users who have shared their data with the entity as a whole. The second level of private contact data includes the entity's entity-wide private contact data. This type of private contact data is not based from personal relationships, but from an organization's perspective. For example, persons attending a conference sponsored by an entity may fill out an attendance or survey form. These forms may be entered into the private contact database and referred to herein as the second level data. A third level includes each user's private data that they consider top secret and decide not to share with the entity as a whole. All the levels of private data may be used to generate the user's and the entity's contact pathway." (Col. 8, lines 26-61.)

The exact language of this portion, describes the manner in which de l'Etraz creates a merged or combined database, whether as a single database or multiple, linked databases. The language explicitly omits any comparative step, however, and further emphasizes that de l'Etraz emphatically does not compare separate contact lists or the identifying of contacts common to the compared lists. The result of de l'Etraz, accordingly, is not a set of common contacts, but rather a "merged" or "combined" database that *adds* private contacts, common or not, to an organization database so as to enlarge the organization's "sphere of influence."

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Another portion of de l'Etraz cited at page 3 of the Office Action, does refer to a comparison. The comparison made by de l'Etraz, however, is not a comparison of two distinct sets of contacts of two different users. Moreover, the comparison in de l'Etraz does not identify common contacts in separate lists. Instead, with de l'Etraz, a comparison is used to determine whether a single, private contact that is to be *added by a user* to a private database is already contained within a public database. The comparison, moreover, is not effected as a computer-implemented procedure, but instead as a user's response to a query. Regardless, though, the result is merely a determination of whether a contact that is to be added in order to enlarge the public database method is the same as an existing contact in the public database. The enlarging of the public database has nothing to do with either the comparison of separate contact lists to determine contacts common to both. Again, the exact language of the cited portion is instructive:

"In an embodiment of the present invention, as users enter their private contact information into the private database 104, these names are checked against the public database 102. For example, as a user enters (manually or via batch process) a contact 'John Smith,' the CIDM system 100 will search the database(s) 102 for 'John Smith.' If a match is found, the CIDM system 100 will query the user via a GUI screen 108, whether, for example, their contact 'John Smith' is the same 'John Smith' who is on the board of the XYZ Company. This process allows, as described below, the user's contact pathway to be generated and displayed within the CDIM system 100.

As the language makes explicit, the de l'Etraz comparison merely leads to a prompt requesting that the *user* determine whether the user's contact 'John Smith' is the same 'John Smith' already contained in the public database. No computer-implemented comparison of two separate contact lists is made. More fundamentally, no matter how

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many times users correctly determine that a contact such as "John Smith" that is about to be added is the same or not the same as the "John Smith" or other contact already contained in the database, the result is a "merged" or "combined" database contacts that may or may not be common to two or more users. Indeed, since the overarching purpose is to enlarge the public database, it is likely that many – if not the majority – of the contacts in de l'Etraz's merged database will not be common among users. The very objective is to build a database reflecting an enhanced "sphere of influence" by including "user's contacts, the contacts of the user's contacts, and so on." (Col. 3, lines 34-39.)

It follows that de l'Etraz merged or combined database never is a database that comprises a set of common contacts identified by comparing entirely distinct databases. Consider in the context of de l'Etraz, the case in which no user enters any contact that is already contained in the public database. In this event, no comparison is ever made, according to de l'Etraz. Moreover, the resulting database contains not a single contact that is common to any two users. This is fundamentally different from Applicant's invention.

The cited portions of de l'Etraz must be read in their complete context. When so read, the remaining portions of de l'Etraz clearly demonstrate the de l'Etraz's comparison has nothing to do comparing separate contact lists in order to identify common contacts. Instead, the comparison in de l'Etraz is explicitly intended to determine whether a contact about to be added by a user to an enlarged or merged database is the same as one already contained in the database. Again, the language of the reference explicitly makes this point:

In the enterprise versions of the CIDM tool, many users within the entity employing the CIDM system 100, however, will allow multiple copies of the 'John Smith' record to exist in the public database 104, while linking each of those records to the one 'John Smith' record in the public database

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102. This may be achieved through the use of, for example, the PartyId, OrgPartyId, and OwnerID fields of the Party table 312. This allows each of the several enterprise users to hold their own personal information about 'John Smith' (e.g., different contact numbers, different degrees of familiarity, etc.), while allowing an enterprise user to generate several, and locate the optimal contact pathway to John Smith via records of PersonRelations table 318." Col. 15, lines 53-67.)

In yet another portion cited in the Office Action, the exact language of de l'Etraz reads as follows:

"Alternatively . . . a contact pathway may be displayed as a node diagram where the nodes denote organizations and the links denote the people that form the associations between the nodes (i.e., organizations)" (Col. 18, lines 9-13.)

The language of this cited portion thus further reveals that de l'Etraz has nothing to do with retrieval and comparison of separate lists, and that de l'Etraz fails to teach, expressly or inherently, a retrieval and comparison of contact lists that results in an identification of contacts common to both. Instead, as the explicit language describes, de l'Etraz "merges" separate data to produce a database commensurate with an enlarged sphere of influence. As already demonstrated, however, while such merging may increase a sphere of influence, it is incapable of producing a set of common contacts, as with Applicants' invention.

It follows that de l'Etraz fails to teach, expressly or inherently, any of the features recited in independent Claims 1 and 12. Applicants, therefore, respectfully maintain that the claims define over the prior art. Applicants further respectfully assert that whereas

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dependent Claims 2, 3, 13, and 14 each depend from one of the independent claims, these dependent claims likewise define over the prior art.

Claims 4, 5, 15 and 16

Independent Claims 4 and 15 are also directed, respectively, to a computerized method and machine-readable storage for generating a list of common contacts. One step recited in both claims is

exchanging at least two contact lists over a physical communications link, wherein each contact list defines a distinct set different from the other and corresponds to a different user.

At page 4 of the Office Action, it is asserted that the same feature is found in de l'Etraz. The portions of de l'Etraz cited in support of the assertion read as follows:

"[T]he CIDM system 100 includes a public information database 102 and a private contact information database 104. In an embodiment of the present invention, these two databases can be mirrored for fault tolerance and thus shown as databases 102a-b and 104a-b.

"The components of the CIDM system 100, as shown in FIG. 1B, are divided into two regions – 'inside' and 'outside.' The components appearing in the inside region refer to those components that the contact intelligence service provider would have as part of their infrastructure in order to provide the tools and services contemplated by the present invention. As will be apparent to one skilled in the relevant art(s), all of the components 'inside' of the CIDM system 100 are connected and

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communicate via a wide or local area network (WAN or LAN) running a secure communications protocol (e.g., secure sockets layer (SSL))." (Col. 7, lines 5-19.)

"Alternatively, referring to FIG. 25B, a contact pathway may be displayed as a node diagram where the nodes denote organizations and the links denote the people that form the associations between the nodes (i.e., organizations.)" (Col. 18, lines 9-12.)

"In yet another embodiment, a stand alone or enterprise user may have access to several public databases 102 which include true public data and quasi-public data. Referring to FIG. 26, a block diagram illustrating the physical architecture of a CIDM system 100 is shown. The enterprise user, as an employee of the enterprise and their PC or work-station 106, has access to the enterprise-wide (quasi) private databases 104b and 104c. The quasi-private database 104b includes the private contact information (first level) data shared by the several users of the enterprise, while the private database 104c contains the form (second level) data collected by the enterprise. The user also has access to their own (top level three) secret private database 102 while using the CIDM tool over the Internet 118, via the enterprise network LAN or WAN 122.

"The CIDM provider can also provide the enterprise users with several quasi-public databases 102. . . . These databases, in an embodiment of the present invention, can represent, for example, a university's alumni database 102b, and a private social club database 102c. Thus, if the enterprise user were also an alumni of the university and/or a member of

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the national social club, these databases can be accessed and used to display broader spheres of influence contact pathways." (Col. 18, lines 33-58.)

The explicit language of the cited portions reveals that de l'Etraz does not contemplate an exchange of contact lists wherein each contact list defines a distinct set different from the other and corresponds to a different user, as recited in independent Claim 4. Instead, de l'Etraz expressly describes the sharing, at different levels (one through three), of an enterprise-wide database or linked databases by all members of the enterprise. All the members of the enterprise may contribute contacts to the database or linked databases – indeed, this is de l'Etraz's overarching goal of building a "sphere of influence" database which comprises "user's contacts, the contacts of the user's contacts, and so on" (Col. 3, lines 34-39) – but no two distinct members of the enterprise ever exchange *different* user-specific contact lists, as recited in independent Claims 4 and 15.

Independent Claims 4 and 15 further recite the following steps:

comparing contacts in said exchanged contact lists to identify matching contacts;

and,

generating and storing a contact list defining yet another distinct set and containing said matched contacts.

Because de l'Etraz does not involve an exchange of contact lists defining distinct sets different from one another and corresponding to different users, it follows that de l'Etraz is incapable of identifying matching contacts contained in different lists, as further recited in independent Claims 4 and 15. More fundamentally, as already pointed out, the

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explicit language of the reference demonstrates that de l'Etraz does not contemplate a comparison that identifies common contacts contained in distinct contact lists. Instead, de l'Etraz only describes a comparison to determine whether a contact about to be added to an existing list is already contained in the list. The result that follows in de l'Etraz is a prompt to the user who is seeking to add the contact requesting that the user determine whether the to-be-added contact is indeed the same as the existing one. As already noted, no comparison of distinct contact lists of two different users is contemplated by de l'Etraz.

It further follows that the contact list of de l'Etraz, created by users adding contacts to an enterprise-wide list in order to create a list reflecting an enhanced sphere of influence, never generates a list of the type recited in independent Claims 4 and 15. Specifically, de l'Etraz never generates a wholly separate and distinct list comprising only a set of contacts identified as being common to two separate contact lists of two different users.

Applicants respectfully submit, therefore, that independent Claims 4 and 15 each define over the prior art. Applicants further respectfully assert, moreover, that whereas dependent Claims 5 and 16 each depend, respectively, from Claims 4 and 15 while reciting additional features, the dependent claims likewise define over the prior art.

Claims 6 and 17

Independent Claims 4 and 15 are also directed, respectively, to a computerized method and machine-readable storage for generating a list of common contacts. The steps recited in each of the claims include

accessing a contact list defining a set being stored in a remotely accessible database of contacts;

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comparing contacts in said contact list with contacts in a stored database of contacts defining another distinct set, said contact list and said contacts in a stored database of contacts each corresponding to a different user;

*producing matching contacts as a result of said comparing; and
providing a visual hyperlink for each matching contact produced by said comparing step.*

For the reasons already stated, de l'Etraz fails to teach, either expressly or inherently, at least two of the recited steps. Firstly, de l'Etraz fails to expressly or inherently teach the comparing of contacts in separate contact lists that each define a distinct set corresponding to a different user. Secondly, de l'Etraz fails to expressly or inherently teach producing matching contacts based on such a comparison. Accordingly, Applicants respectfully submit that independent Claims 6 and 17 each define over the prior art.

Claims 7-11

Independent Claim 17 is directed to a system for identifying common contacts. The features of the system recited in the claim comprise

at least two contact lists, each said contact list defining a distinct set comprising a plurality of contacts, each said contact list having a publicly accessible interface through which said contacts can be accessed remotely, each said contact list corresponding to a different user;

a comparator for comparing contacts in each of said at least two contact lists, said comparator identifying matching contacts in each of said at least two contact lists; and,

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a common contact list resulting from the comparison and defining yet another distinct set comprising contacts matched by said comparator.

None of these features are found in de l'Etraz. As already noted, the system of de l'Etraz is directed to building a database reflecting an enhanced "sphere of influence" of a corresponding enterprise or organization. The de l'Etraz system builds such a database by merging or combining other databases. User's, who are members of the enterprise or organization, can add contacts to the database. Although, a member that is adding a contact may be prompted for a determination of whether a to-be-added contact is the same as one already contained in the database, no common contacts from separate contact lists are identified.

More particularly, for reasons already stated, de l'Etraz's system makes no comparison between two wholly distinct contact lists associated with different users; that is, de l'Etraz fails to expressly or inherently teach a comparator for comparing contacts in two contact lists, as recited in independent Claim 7. Without making such a comparison, de l'Etraz's system is incapable of further identifying contacts common to the two distinct contact lists, as also recited in independent Claim 7. It follows, therefore, that de l'Etraz's system further lacks a common contact list that results from the comparison and that defines yet another distinct set comprising contacts matched by the comparator.

Thus de l'Etraz fails to expressly or inherently teach every feature of the system recited in independent Claim 7. Applicants respectfully submit that independent Claim 7, therefore, defines over the prior art. Applicants further respectfully submit that whereas dependent claims 8-11 dependent from independent Claim 7 while reciting additional features, the dependent claims likewise define over the prior art.

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CONCLUSION

The Applicants believe that this application is in full condition for allowance, which action is respectfully requested. The Applicants invite the Examiner to call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: January 25, 2006



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